

REMARKS/ARGUMENTS

Claims 1-23 are pending in the present application. Claim 23 was canceled; claims 1-22 were amended; and no claims were added.

Support for the substantive amendments is found in the drawing and specification as follows: Figure 2, 106, Figure 3, 152, original claims.

Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness (Claims 1-23)

The Examiner has rejected claims 1-23 under 35 U.S.C. § 103 as being unpatentable over Freeman et al., U.S. Patent Application Publication No. 2001/0013123 (hereinafter “Freeman”), in view of Franco, U.S. Patent Application Publication No. 2002/0046407 (hereinafter “Franco”). Office Action dated September 16, 2009, pp. 2-5. This rejection is respectfully traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Frutch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

A. Claim 1, 6, 12, 17, and 23

Amended claim 1 is representative of claims 6, 12, 17 and 23 because the same distinguishing amendment has been applied to each claim. Therefore, arguments applied to claim 1, to the extent they refer to the same limitation as discussed for claim 1, apply to claims 6, 12, 17 and 23 as well.

The examiner's rejection of claims 1 and 6 were similar. In rejecting claim 1, the Examiner states:

Regarding Claim 1: Freeman et al and Franeo discloses a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising: receiving a television program containing an original marketing from a service provider (paragraph 0027 and 0031 of Freeman et al.); storing the television program in the memory (paragraph 0072); sending (paragraph 0079 of Freeman et al.) a user ID (paragraph 0068 of Franeo) and a program ID (paragraph 0041 and 0064 of Freeman et al.) to the service provider to cause a local marketing content (paragraph 0015 and 0081 of Freeman et al.), based upon the user ID and the program ID, to be sent to the DVR; (paragraph 0090); determining whether a local marketing content has been received at the DVR (paragraph 0064); responsive to the determination that the local marketing content has been received at the DVR (paragraph 0064), creating a modified marketing by modifying the original marketing with the local marketing content (paragraph 0090); and displaying the television program with the modified marketing upon a user request (paragraph 0090 and fig. 1 a element 110).

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine Franeo invention into of Freeman et al. invention in order to store a user requested program at the user station.

Office Action dated September 16, 2009, pp. 2-5.

Amended claim 1 recites:

A method for modifying an original marketing content stored within a memory of a Digital Video Recorder (DVR) comprising:
sending, by a processor of a service provider, a television program containing an original marketing from the service provider, to a DVR;
receiving, by the processor, a user ID and a program ID from the DVR;
and
responsive to receiving the user ID and the program ID at the processor, determining, by the processor, a location of the user by referencing a user profile associated with the user ID, and sending by the processor, a local marketing content to the DVR, wherein the local marketing content is based on the location of the user and the program ID.

Amended claim 1 is directed to the service provider. Amended claim 6 is directed to the DVR. Amended claim 12 is directed to the DVR and amended claim 17 is directed to the service provider. Amended claims 1 and 6 are representative of claims 17 and 12 respectively, and arguments made in regard to claims 1 and 6 apply to claims 17 and 12 as well.

Amended claim 1 distinguishes over the cited art, individually or in combination for the following reasons. First, the cited art is silent in regard to the following limitation: “responsive to receiving the user ID and the program ID at the processor, determining, by the processor, a location of the user by referencing a user profile associated with the user ID, and sending by the processor, a local marketing content to the DVR, wherein the local marketing content is based on the location of the user and the program” because the limitation requires that the service provider processor receive the user ID and the program ID before sending local marketing content. Thus, when the IDs are received, the local marketing content is sent automatically (“responsive to”) to the DVR. This feature is not found in any of the cited art, nor can it be carried out by a combination of any of the cited art.

Amended claim 6 recites:

A method for modifying a marketing content stored within a memory of a Digital Video Recorder (DVR) comprising:
responsive to a processor of the DVR storing a television program having the marketing content, in the memory, sending, by a processor of the DVR, a user ID and a program ID to a service provider;
responsive to receiving, by the processor, a local marketing content from a service provider in response to sending the user ID and the program ID, replacing the marketing content with the local marketing content in the memory.

Amended claim 6 distinguishes over the cited art, individually or in combination for the following reasons. First the cited art is silent in regard to the following limitation: “responsive to a processor of the DVR storing a television program having the marketing content, in the memory, sending, by a processor of the DVR, a user ID and a program ID to a service provider.” The user ID and the program ID are sent when the processor stores the television program. Thus, when a television program is received and stored, the IDs are sent automatically (“responsive to”) to the service provider. This feature is not found in any of the cited art, nor can it be carried out by a combination of any of the cited art.

The cited art does not disclose the foregoing features. Freeman teaches (1) sending all content all the time to all receivers, and letting the receivers tailor the viewed program by

selecting the desired segments, and (2) sending generic content to the all receivers and additionally sending user targeted content. However, Freeman does not teach the elements and cooperation of the elements of amended claim 1 and amended claim 6. None of the other art, in combination with Freeman remedies this deficiency.

Although Freeman may have some similar appearance to portions of Claim 1 or Claim 6, this similar appearance is due only to Freeman's teaching of a system for creating targeted content for an identified user. Freeman's method of operation is quite different from Claim 1 and Claim 6. Freeman is different because Freeman uses a hub and spoke system. In the hub and spoke system of Freeman, all of the processing work is performed at the hub (see Freeman Abstract, Summary of the Invention, and paragraph [0027]). In contradistinction, Claim 1 and Claim 6 divide the work between the service provider and the DVR. But the division of work is not the only reason that Claim 1 and Claim 6 are novel. Claim 1 is novel because the service provider distributes the local marketing content only upon a request from a DVR which has recorded a program and sent a user ID and a program ID to the service provider. Only then does the service provider send to the DVR targeted content for the user and for the program that was recorded. Correspondingly, in Claim 6, the DVR does not receive marketing content until the DVR has sent out a user ID and a program ID, and that takes place after recording a program. This feature occurs automatically or "responsive to" storing the program in the DVR.

Franco does not remedy any of the deficiencies of Freeman. Franco teaches one or more systems for remotely programming a DVR from a computer over a network. Applicant believes that examiner combines Freeman and Franco only in order to add the user ID to Freeman. Applicant's understanding of the Examiner's reasoning is based on the Examiner's statement that:

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine Franco [sic] invention into of Freeman et al. invention in order to store a user requested program at the user station.

Applicant disagrees with the Examiner's reasoning. Freeman is only concerned with creating and distributing enhanced content for the users of a service provider. Applicant can see no basis for introducing the additional feature of a remote user logging into a web site to remotely control his DVR other than the patent mentions a user ID. However, Freeman is silent in regard to remote operation of the DVR. Freeman has a recording feature. Freeman does not

have a remote capability. Indeed no remote capability is required in Freeman because the DVR / Receiver is local to the user and therefore no remote login to the DVR of Freeman is required. In addition, Claim 1 does not recite remote operation. In Claim 1 and Claim 6 a user ID and a program ID are provided by the DVR to the service provider for the explicit purpose of requesting additional content from the service provider. Neither Claim 1 nor Claim 6 recite a feature of remotely recording a program via a user logging into a web site at the service provider that then controls the users DVR through the service provider.

Assuming *arguendo* that Freeman and Franco could be combined by re-engineering Freeman's receiver and service provider to support Franco's features. The combined invention would still not teach the claim elements of the applicant. Specifically, in such a case, the request to record the video would come from a remote computer using Franco's user ID, and then Freeman's service provider would receive the request and distribute the custom program to the user's DVR. Such a merger of the inventions of Freeman and Franco would still fail to teach the novel aspect of Claim 11 as discussed above because the combination is silent in regard to the DVR sending a request when it stores a program, and the service provider sending local marketing content based on a user location and program ID.

B. Claims 2-5, 7-11, 13-16, 18-22 and 23

Claim 23 has been canceled. Claims 2-5 depend from claim 1. Claims 7-11 depend from claim 6. Claims 13-16 depend from claim 12. Claims 18-22 depend from claim 17. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Therefore, the rejection of claims 1-23 under 35 U.S.C. § 103 has been overcome.

II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,
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